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Ropes & Gray LLP
Patent Docketing 39/41
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In re Application of
HANNON et al.
Application No.: 10/524,690
PCT No.: PCT/US03/30901
Int. Filing Date: 29 September 2003
Priority Date: 27 September 2002
Attorney Docket No.: CSHL-P01-011
For: CELL-BASED RAN INTERFERENCE
AND RELATED METHODS AND
COMPOSITIONS

DECISION ON REQUEST

This decision is issued in response to applicants' "Communication in Response to Notification of Defective Response" filed 15 May 2007, which is being treated as a request under 37 CFR 1.497(d) to correct the inventorship of the present national stage application. The \$130 petition fee will be charged to counsel's Deposit Account.

BACKGROUND

On 29 September 2003, applicants filed international application PCT/US03/30901 which claimed a priority date of 27 September 2002. The published international application identified nine applicant/inventors for the United States: Jordin Fridman; Gregory J. Hannon; Michael Hemann; Scott W. Lowe; Patrick J. Paddison; Jack Zilfou; Ross Dickens; Michelle A. Carmell; and Thomas A. Rosenquist. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 27 March 2005.

On 15 February 2005, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee; a preliminary amendment; and a copy of the international application.

On 23 February 2006, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 01 September 2006, applicants filed a declaration and a five month extension of time.

On 21 November 2006, applicants filed "Second Preliminary Amendment and Correction of Inventorship under 37 CFR 1.48(b)."

On 26 April 2007, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the declaration was defective because the fifth inventor (Stephen J. Elledge) was not identified on the international application.

On 15 May 2007, applicants filed the present request under 37 CFR 1.497(d) to add Stephen J. Elledge as an inventor.

DISCUSSION

The present submission seeks to correct the inventorship so as to add inventor Stephen J. Elledge to the application. Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d), which states the following:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17; and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).
- (4) any new oath or declaration required by paragraph (f) of this subsection.

With respect to the adding Stephen J. Elledge to the application, applicants' 15 May 2007 submission satisfies requirements (1) and (2).

Regarding item (3), applicants have submitted a document(s) entitled "Consent of Assignee to Correct Inventorship Pursuant to 37 CFR 1.497(d)(3)." This document states that the assignees consent to the addition of Stephen J. Elledge as an inventor herein. However, pursuant to 37 CFR 1.497(d)(3), the consent of the assignee must be submitted in compliance with 37 CFR 3.73(b) (see MPEP 201.03(II)(D)). Here, the statement executed by the assignee does not comply with the requirements of 37 CFR 3.73(b)(2). Specifically, the person (John Maroney and Chester Bisbee) signing the "Consent of Assignee" does not have apparent authority to act on behalf of the assignee or states that he is authorized to act on behalf of the assignee. Item (3) is therefore not satisfied.

Regarding item (4), the 01 September 2006 submission included an executed declaration. However, this declaration is not in compliance with 37 CFR 1.497. Specifically, the thirteen page document submitted by applicants appear to be a compilation of multiple copies of a six-page declaration (the filed materials include four copies of "Page 4 of 6" and four copies of "Page 5 of 6"). Such compilation is impermissible; see MPEP § 201.03: "Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration." Copies of the complete declaration executed by each of the inventors is required before the declarations can be accepted under 37 CFR 1.497.

Additionally, the declaration is not in compliance with 37 CFR 1.497 (a)-(b) in that it gives the impression that Jack Zilfou and Stephen J. Elledge are the "fifth inventor" for the present application. Accordingly, a declaration in compliance with 37 CFR 1.497 is still required.

For the reasons discussed above, it is inappropriate, at this time, to grant applicants request for correction of inventorship.

CONCLUSION

Applicants' request to add inventor Stephen J. Elledge under 37 CFR 1.497(d) is **DISMISSED** without prejudice. The inventors of record remain the inventors named on the international application.

Applicants' request under 37 CFR 1.48(b) will be held in abeyance pending the submission of a fully executed oath or declaration in compliance with 37 CFR 1.497.

Applicants must file a proper response to this decision within **TWO (2) MONTHS** from the mail date indicated above. A proper response must include a declaration in compliance with 37 CFR 1.497(a)-(b) and a written consent of assignee in compliance with 37 CFR 3.73(b). Failure to file a timely and proper response will result in abandonment of the application. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, Commissioner for Patents, P.O. Box 1450,

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Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read "Anthony Smith". The signature is written in a cursive, flowing style.

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